

Applicant(s): James A. Perkins, et al.
Application No.: 10/828,843
Filing Date: April 21, 2004
Confirmation No.: 5307
Title: System for Inline Stripping of Soil Contaminants
Examiner: Robert J. Popovics (571) 272-1164
Group Art Unit: 1724

REQUEST TO WITHDRAW FINALITY OF REJECTIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated June 20, 2007, and pursuant to M.P.E.P. 706.07, Applicants respectfully submit that the finality of the prior art rejections set forth was premature. Consideration of the relevant facts and Patent Office policy establish that the latest refusal of the claims should not have been made final, thereby constraining Applicants' options for responding to the Office Action. Accordingly it is submitted that the same should be withdrawn and the rejections be deemed non-final.

The Prior Art Rejections

In the Office Action of February 12, 2007, the Examiner finally rejected Claims 1, 3 – 6, 9 – 12, 14, and 16 – 20 as allegedly anticipated by U.S. Patent No. 5,352,276 to Rentschler et al. ("Rentschler"). Claims 7 and 8 were objected to as being dependent upon a rejected base claim, but the Examiner said these claims (Claims 7 and 8) would be allowed if rewritten in independent form. Claims 21 – 33 were said to be allowed.

The Examiner did an about face after receiving Applicant's proposed after-final amendment dated April 12, 2007. He refused to enter this amendment, which was based entirely on the examiner's indications of the allowability of Claims 7-8 and 21-33, and instead

issued a new Office Action. Instead of accepting the amendments he previously invited the Applicants to make, the Examiner withdrew the finality of the February 12, 2007, and at the same time, issued a new and different final Office Action based on entirely new and different prior art.

This is unfair and improper. Applicants' amendments simply adopted the Examiner's suggestions about what claims would be deemed allowable. Applicants' amendments did not prompt any new grounds of rejection or raise new issues.

In the new Office Action, Claims 1, 3 – 6, 9 – 12, 14, and 16 – 20 were again finally rejected as allegedly anticipated by the Rentschler patent. The Examiner also issued a new series of alleged obviousness rejections. Claims 1, 3 – 12, 14, and 16 – 33 were newly rejected as allegedly being obvious over a newly cited reference, U.S. Patent No. 4,861,352 to Cheng, taken in combination with a newly cited series of alleged prior art "Admissions" suddenly found within Applicants' specification. Claims 1, 3 – 12, 14, and 16 – 33 were also rejected as allegedly being obvious over the three-part combination of the Rentschler patent, the Cheng patent, and the alleged prior art Admissions.

It is Applicants' understanding that each of these new obviousness rejections is also prefaced upon a series of underlying facts for which the Examiner supposedly takes as being true by Official Notice of in the current Office Action. Specifically, the Examiner purports to take Official Notice of the following facts:

1) MTBE is a well known contaminant found in groundwater due to gasoline spills, or leakage from gasoline storage tanks.

2) Removal of MTBE and other hydrocarbon / volatile water contaminants using various stripping techniques, is well known to those skilled in the art.

3) The use of venturis, venturi type devices, entrainment devices, jet pumps, eductors, ejectors, fans, pumps, blowers, motive fluid devices, etc., to generate suction, or create a vacuum, or reduced pressure region, is well known to those skilled in the art.

4) The ARTX Air Amplifier is a known, commercially available, prior art entrainment device, that is marketed to create a strong vacuum or to manipulate the velocity of a fluid using compressed gas.

5) Application of vacuum, reduced pressure or suction to a liquid having hydrocarbons or volatiles contained/dissolved therein results in those compounds coming out of the water - Henry's Law. (Henry's Law: At a constant temperature, the amount of a given gas dissolved in a given type and volume of liquid is directly proportional to the partial pressure of that gas in equilibrium with that liquid.)

6) The use of multiple stages, or a series of treatment devices in series is well known in the art to multiply the effect of a single stage. Entire college courses (e.g., Unit Operations) are largely devoted to the study of multiple stage separations.

In addition to supposedly taking "Official Notice" of these facts, the Examiner encloses copies of a group of newly cited articles found in various scientific publications, presumably as alleged evidence of the facts which are being Officially Noticed:

"MTBE Fact Sheet # 2: Remediation of MTBE Contaminated Soil and Groundwater." EPA. January 1998.

"Methyl Tertiary Butyl Ether (MTBE) Bioremediation." TechData Sheet, Navel Facilities Engineering Command (September 2000).

Lawuyi, et al. "Perspectives on Specific Substances: Methyl tert-Butyl Ether (MTBE)." Handbook of Hazardous Materials Spill Technology (2002).

Keller et al. "Cost and Performance Evaluation of Treatment Technologies for MTBE-Contaminated Water." (Journal and Publication Date Unknown)

Keller et al. "Advances in Groundwater Treatment to Remove MTBE." Proceedings of the 31st Mid-Atlantic Industrial and Hazardous Waste Conference, University of Connecticut. (June 20-23, 1999).

In view of all of the foregoing, it is submitted that the finality the prior art rejections in the current Office Action is, to say the least, premature. It should be withdrawn so Applicants could have a fair and complete chance to deal with all this new information alleged for the first time to render their claims unpatentable.

Standards for Final Rejections

The standards for issuing a final rejection are explained in the Manual of Patent Examining Procedure at Section 706.07 which advises that:

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," *present practice does not sanction hasty and ill-considered final rejections*. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. ... The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be

developed, if possible, before appeal.

M.P.E.P. § 706.07 (emphasis added). It is further explained that

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

M.P.E.P. § 706.07(a) Thus, a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims.

The Finality of the Current Rejections is Premature

Under the above standard, the rejections in the current Office Action should have been made non-final, rather than final. The Examiner's grounds for the obviousness rejections are entirely new. The Cheng patent has not been previously cited in any prior art rejection nor have any of the alleged prior art Admissions previously been cited in a prior art rejection. These grounds of rejection are all entirely new.

Perhaps even more significant are the Examiner's Official Notices. While the Examiner has not cited them directly as prior art references, the publications included as evidence in support of the Official Notices have, in effect, been used as prior art references for the propositions set forth in the Notices. As a practical matter, then, Applicants have been presented with half a dozen new alleged prior art references in a final rejection.

Moreover, the citation of these new references certainly cannot reasonably be said to necessitated by Applicants' amendment of the claims because the Examiner refused to enter the claim amendment proposed by the Applicants in their April 12, 2007 response!

Thus, the Examiner's new final prior art rejections are improper on their face since they are based upon new grounds of rejection which were first introduced by the Examiner in this Office Action and which were clearly not necessitated by Applicants' amendment of the claims. These were amendments invited by the Examiner's own comments to the effect that claims amended in this manner would be allowed. Accordingly, Applicants urge the Examiner

to withdraw the finality of the current prior art rejections and make the current Final Office Action non-final in nature.

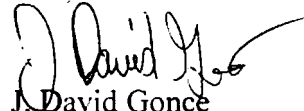
Applicants also ask that the Examiner respond provide his response to this Request as soon as possible and prior to the expiration of the shortened statutory period for reply to the final Office Action so that Applicants will be able to determine whether they should respond to the rejections on the merits via an amendment in the present case or via a continuation application.

In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our **Deposit Account No. 12-2355**.

Respectfully submitted,

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Date: September 5, 2007

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